

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/578,536

Applicant(s)

WAHL ET AL.

Examiner

Louis Wollenberger

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 July 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Louis Wollenberger/
Primary Examiner, Art Unit 1635
August 3, 2010

Continuation of 3. NOTE: The amendments to the claims filed 7/27/2010 introduce the limitations "to a cell contacted with HIV" and "di-CDDO", which have not been previously required by the claimed method as a whole and would therefore require a reconsideration of the applied art and rejections of record as well as new searches and considerations of the prior art as it may bear on the claimed method as a whole. Applicant further introduces new claim 35, drawn to a method of "inhibiting HIV-1 replication in an individual" and providing an inhibitor in an amount and duration sufficient to cause "attenuation of at least 50%" in the propagation of HIV, wherein said inhibitor is CDDO or di-CDDO. The full scope of the method defined by claim 35, with all its limitations, has not been previously searched and considered for patentability.

Continuation of 11. does NOT place the application in condition for allowance because: the arguments traversing the rejections of record are directed to the claims as amended after final rejection on 7/27/2010. However, the amendments filed 7/27/2010 have not been entered for the reasons given above.

In the interest of advancing prosecution of the instant application, Applicant's remarks have been reviewed. Applicant's assertion the claims do not read on CDDO derivatives is well taken. However, Applicant is reminded that with regard to the rejection of the claims for lack of enablement, set forth in the actions mailed 5/6/2010 and 12/2/2009, the rejection had raised questions as to whether the totality of the evidence was correlative of a method for attenuating any immunodeficiency virus (claim 1 as filed 2/26/2010) or for a treatment of AIDS. It is also noted the previous response filed by applicant on 2/26/2010 did not traverse the previous enablement rejection with regard to the scope of the claims directed to any immunodeficiency virus or the treatment of AIDS in light of the amendments to the claims filed on 2/26/2010 and in the manner required by 37 CFR 1.111(b) and (c). Accordingly, the rejection was maintained for the reasons of record. Applicant's assertion the finality of the previous Action should be withdrawn based solely on embodiments the Examiner may have generally indicated as enabled and/or described is unpersuasive. Such claims, if presented, must, nevertheless, be searched and considered on the merits with regard to all relevant statutes.

It is also noted the remarks filed 7/27/2010 refer to a publication in the Journal of the National Cancer Institute. In order to have information considered by the Office during the pendency of a patent application, an information disclosure statement must be (1) in compliance with the content requirements of 37 CFR 1.98, and (2) filed in accordance with the procedural requirements of 37 CFR 1.97. MPEP 609. The journal article submitted by applicant and discussed in the remarks has not been cited in an IDS.